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In re Application of
BURNS
Application No.: 10/006,017 : DECISION
Filing Date: 04 December 2001 :
Atty. Docket No.: 717901.19 :
For: PLAYING SURFACE SUBSTRATE, IN
PARTICULAR TURF MATS : :

This is a decision on applicant's "Petition For Correction of National Phase Filing For a Patent Application Under 37 CFR Section 1.182" filed on 19 February 2002 in the United States Patent and Trademark Office (USPTO). The \$130 petition fee has been paid.

BACKGROUND

On 02 June 2000, applicant filed international application PCT/GB00/02134, which claimed priority of an earlier British application filed 04 June 1999. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 04 December 2001.

On 04 December 2001, applicants filed a utility patent application transmittal letter in the United States, which was accompanied by, *inter alia*,: \$370 basic filing fee, a declaration for utility or design patent executed by the sole inventor and a "Preliminary Amendment." The application was processed as a filing under 35 U.S.C. 111(a).

DISCUSSION

Applicant's transmittal letter filed 04 December 2001 did not request treatment under 35 U.S.C. 371 but rather was for a new nonprovisional application under 37 CFR 1.53(b). The declaration filed 04 December 2001 however, did identify PCT International Application number PCT/GB/00/02134. Thus, it was unclear what type of application applicant was intending to file. Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). (See 37 CFR 1.494(f) and 37 CFR 1.495(g)). In addition, section 1893.03(a), page 1800-114 of the MPEP states that "[i]f there are any conflicting instructions as to whether the filing is under 35 U.S.C. 111(a) or 35 U.S.C. 371, the application will be accepted as filed under 35 U.S.C. 111(a)." As such, the application was properly treated as an application under 35

U.S.C. 111 and 37 CFR 1.53.

Furthermore, U.S. statutes and regulations do not make specific provision for the requested action and as such, the Office does not grant such petitions for conversion as a mere matter of course. The Office will only grant such petitions upon a showing by applicant of sufficient cause (i.e., the loss of patent rights) where no other remedy is available.

Applicant is entitled to claim benefit under 35 U.S.C. 120 and 365(c) of the filing date of the international application for the common subject matter, if this application (Application No. 09/006,017) and the international application (PCT/GB00/02134) designating the United States were copending on 04 December 2001. In order to obtain benefit of the earlier international application, applicant must amend the beginning of the specification of this application by inserting a proper reference to the parent international application. An appropriate passage would be, "This is a continuation of international application PCT/GB00/02134), filed 02 June 2000 which designated the United States and is now abandoned."

Applicant is reminded that in order to perfect the claim for priority under 35 U.S.C. 119, applicant must submit a certified copy of the priority document. The certified copy of priority document submitted to the International Bureau for the national stage cannot be relied upon to perfect the claim for priority. See MPEP § 1896.

CONCLUSION

The petition to convert the application from a 35 U.S.C. 111 filing to a national stage application under 35 U.S.C. 371 is **DISMISSED** without prejudice.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.182." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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